

REMARKS

Claims 1-34 are currently pending in the application. Applicants respectfully request reconsideration of the instant application in view of the following remarks.

Rejection Under 35 USC § 103

Claims 1-34 have been rejected under 35 U.S.C. § 103 as being unpatentable over the Examiner's assertion of Admitted Prior Art in view of Brendan Coffey "Compliance Moves Forward"(Wall Street & Technology, New York; pg. 28, 3 pages). Applicants respectfully traverse the rejection and submit the pending claims are patentably distinct for at least the following reasons.

Independent Claim 1 Is Patentable

Applicants request reconsideration of independent claim 1 and the other claims directly or indirectly dependent therefrom. Regarding independent claim 1, the Examiner indicates on page 8, ¶1, "claim 1(b),...restriction', the applicant's arguments are responded in response to the claims [on page 2, ¶3], above as it applies." With regard to claim 1 on page 2, ¶3 of the Office Action, the Examiner asserts:

“(b)” retrieving restrictions associated with the particular instrument from a collection of restrictions (APA page 2 lines 6-9 ‘the TCO compares the ... Known to the public.’ - in order to compare the security with list of companies with which the employee is involve [sic], it is obvious that TCO has to pull out/obtain the list/restrictions from his drawer, the database, notebook, company guideline, memory, etc.)” (emphasis added to delineate new Examiner arguments).

However, the Examiner does not cite a reference to support this assertion. Furthermore, Applicants submit that the Examiner's argument that one should “pull out/obtain

the list/restrictions from his drawer, the database, notebook, company guideline, memory, etc” is based on the application of impermissible hindsight. In the event the Examiner maintains his position, Applicants explicitly request the Examiner provide a reference to support his position.

First, Applicants submit that even *in arguendo* that the Examiner was not applying impermissible hindsight, the Examiner's assertion does not address each and every claimed element recited in independent claim 1. More specifically, Applicants submit that claim 1, element (b), which recites “retrieving restrictions *associated* with the particular instrument from a collection of restrictions.” (emphasis added), is not addressed by Examiner's assertion. The Examiner's asserted list of sources do not include the element of “restrictions associated with a particular instrument” nor any other requirements from claim 1, element (b). Applicants submit, something randomly pulled from a “drawer” is not likely to have an association with the particular instrument. Therefore, even *in arguendo*, considering the Examiner's impermissible assertion in combination with other Examiner references, each and every element recited in independent claim 1 is not taught, disclosed or suggested.

Accordingly, the claimed invention is not rendered obvious under § 103, as recited claim elements have not addressed. Applicants also submit that the Examiner has applied impermissible hindsight making assertions that are not based on cited references or Official Notice. Should the Examiner maintain his position regarding claim 1 element (b), Applicants request the Examiner provide a reference teaching, disclosing, or suggesting the claimed element. Accordingly, Applicants respectfully request that for at least these reasons the Examiner withdraw the rejection, and allow claim 1 (and as a consequence all claims depending therefrom).

Independent Claim 21 Is Patentable

Applicants request reconsideration of independent claim 21 and the other claims directly or indirectly dependent therefrom. Regarding independent claim 21, the Examiner indicates on page 8, ¶1, that “citation ‘issue a query ... Instrument’, Applicant argues about limitation, which is not claimed.” However, Applicants note that claim 21 element (b) does recite: “issue a query to the list server to obtain restrictions related to the particular instrument”. (emphasis added). Applicant requests that the Examiner clarify the rejection based on the alleged absence of the claim element.

Accordingly, Applicants submit that claim 21 is patentably distinct for at least the reasons discussed in the previous response dated June 30, 2006, which are hereby reasserted. As claim 21 element (b) is not taught, disclosed, or suggested in any of the cited references, Applicants respectfully request that the Examiner withdraw the rejection and allow claim 21 (and as a consequence all claims depending therefrom).

Futhermore, as the Examiner's rejection of all other outstanding claims including claims 16-20 (and any claims depending therefrom) are based on a similar rationale, Applicants submit these claims are also patentably distinct for at least the reasons discussed above.

CONCLUSION

Consequently, the reference(s) cited and/or any official notice taken by the office action do not result in the claimed invention, there was/is no motivation for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed inventions are not admitted to be prior art. Thus, the Applicant respectfully submits that the supporting remarks and claimed inventions, claims 1-34, all: overcome all rejections and/or objections as noted in the office action, are patentable over and

discriminated from the cited reference(s), and are in a condition for allowance. Furthermore, Applicant believes that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art. While many other claim elements were not discussed, Applicant does not concede that any such elements are found in the prior art and/or within any official notice taken in the office action, and as such, Applicant asserts that all such remaining and not discussed claim elements, all, also are distinguished over the prior art, including any official notice taken in the office action, and explicitly reserves the opportunity to more particularly remark and distinguish such remaining claim elements at a later time should it become necessary. Further, any remarks that were made in response to an Examiner objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to another Examiner objection and/or rejection as to any other claim element(s), any such re-assertion of remarks is not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim elements, and no such commonality is admitted as a consequence of any such re-assertion of remarks. As such, Applicant does not concede that any claim elements have been anticipated and/or rendered obvious by any of the cited reference(s). Accordingly, applicant respectfully requests allowance, and the reconsideration and withdrawal of the rejection(s) and/or objection(s).

If a telephone conference would facilitate prosecution of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 03-1240, Order No. 17209-019.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 03-1240, Order No. 17209-019

Respectfully submitted,
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